GAU 1656

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Appln. of: Smits et al

Serial No.: 09/600,732

File: July 20, 2000

For: PROCESS FOR THE MANUFACTURE OF CHICORY INULIN ...

Group: 1656

Examiner: S. Chunduru Docket: TIENSE RAFF.26

The Assistant Commissioner for Patents
Washington, D.C. 20231

Response to Restriction Requirement

Dear Sir:

This paper is being filed in response to the Official Action mailed September 28, 2001, wherein the Examiner imposed a restriction requirement, separating the claims into 3 groups. Provisional election is hereby made, with traverse, to prosecute the invention of Group I, comprising claims 29-49. The restriction requirement is respectfully traversed for the reasons as follow.

As the Examiner correctly recognized, pursuant to 37 CFR 1.499 unity of invention for U.S. national stage applications filed under 35 U.S.C. §371 will be determined according to the rules of the PCT. The precise standard for making such determinations regarding unity of invention are laid out in 37 CFR 1.475. However, Applicants respectfully submit that the Examiner has erred in applying the standards laid out in Rule 1.475 for the reasons as follow.

In making the rejection based on lack of unity of invention the Examiner stated, "[t]he European Search Report cited prior art . . . which indicates lack of inventive step in the instant

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claims and hence lacks special technical feature. Hence the Restriction requirement is proper." However, this is a improper understanding and application of the standard.

As an initial matter, and in order to better understand the problem, it is useful at this point to quote 37 CFR 1.475(a), which dictates the applicable unity of invention standard from PCT Rules 13.1 and 13.2, reading in relevant part:

> "Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art." (emphasis added)

In making the restriction requirement, based on lack of unity of invention, the Examiner relies upon the European Search Report which found that the present invention did not contain an inventive step. See, paragraph 1 of the "Detailed Action". The Examiner concluded that the lack of inventive step asserted by the European Search Report would mean that the present invention does not contain "technical features that define a contribution . . . over the prior art" under 37 CFR 1.45. Accordingly, the Examiner concluded that unity of invention could not be established.

Applicants respectfully submit that this reasoning is flawed. In essence, the Examiner has found a lack of unity of invention because the invention has been asserted to lack inventive step. This leaves us in a situation wherein if the invention is patentable there is unity of invention. However, if the invention is unpatentable there is no unity of invention. This, of course, is not the case. A restriction requirement has nothing to do with patentability or unpatentability.

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A more careful reading of the pertinent rules resolves this issue. 37 CFR 1.475(a) tells us that what is critical in determining unity of invention is whether there is "a technical relationship among those invention involving one or more of the same or corresponding special technical features." Unity of invention is found when the inventions contain a common technical aspect or link. The final sentence of the rule, which defines the meaning of "special technical features", merely indicates that this common technical aspect or link must be an aspect which Applicants assert as being a patentable aspect of the invention, that it is at least in part the "special technical feature" or technical character for which Applicants are seeking a patent.

That this is the proper interpretation of the rule is further indicated by paragraph (b) of Rule 1.475, which reads in pertinent part:

> "(b) An international or national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:
>
> ...
>
> ...
>
> (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product;"

By the Examiners own classification the inventions of the present application are drawn to:

Group I, claim(s) 29-49, drawn to a process for the manufacture of chicory inulin

Group II, claim(s) 50-60, drawn to an improved standard or high performance grade chicory inulin

Group III, claim(s) 61-64, drawn to a method of use of improved standard grade chicory inulin

These classifications of inventions made by the Examiner are exactly those permitted by subsection 3 of Rule 1.475(b), quoted above. In summary therefore, all of the claims are

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believed to be directed to a single invention. However, so as to be fully responsive, Applicants provisionally elect to prosecute Group I, i.e., claims 29-49, and it is requested that, without further action thereon, the remaining claims be retained in this application pending disposition of the application, and for possible filing of divisional applications.

In the event the Examiner deems personal contact is necessary, please contact the undersigned attorney at (603) 668-1400.

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our Deposit Account No. 08-1391.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner of Patents, Washington, D.C. 20231 on October 29, 2001, at Manchester, New Hampshire.

By Kyrolina Stevens

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